

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. ³⁷~~4~~

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UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

SEP 16 1998

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

RICHARD A. LERNER and JOSEPH A. SORGE

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Junior Party,

v.

GREGORY P. WINTER, ELIZABETH S. WARD and DETLEF GUSSOW

Senior Party.

Patent Interference No. 104,272

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application, patent (if any), reissue application (if any), count(s) and claim(s) designated as corresponding or not corresponding to the count(s) appear in an "Attachment" to this order.

1. Judge designated to handle the interference

Senior Administrative Patent Judge Fred E. McKelvey has been designated to handle the interference. 37 CFR § 1.610.

2. Telephone calls to the board

Telephone calls to the board regarding this interference shall be placed to 703-308-9797.

Telephone calls in which counsel wish an administrative patent judge to participate shall be inter partes conference telephone calls in which at least one counsel for each party and the administrative patent judge designated to handle this interference shall participate. There are no exceptions. Any attempt to initiate an ex parte telephone call to an administrative patent judge in connection with this interference may result in sanctions (37 CFR § 1.616; 35 U.S.C. § 32; 37 CFR § 10.23(b)(5); 37 CFR § 10.93).

No attempt shall be made to contact any administrative patent judge not designated to handle this interference without prior permission of an administrator (Merrell C. Cashion or Amalia Santiago) or the administrative patent judge designated to handle this interference.

Telephone calls requesting a telephone conference call or information of a procedural nature shall be placed to an administrator. A party seeking a conference call with an administrative patent judge should be prepared to advise the administrator why a conference call is believed to be needed.

3. Filing of papers with the board

The parties may file papers with the board in any of the following manners:

a. Hand-delivery to the Office of the Clerk between the hours of 8:30 a.m. and 5:00 p.m. at:

Board of Patent Appeals and Interferences
Crystal Gateway 2
10th Floor
1225 Jefferson-Davis Highway
Arlington, VA 22202.

b. Commercial overnight delivery service, addressed as follows:

Board of Patent Appeals and Interferences
Crystal Gateway 2
10th Floor
1225 Jefferson-Davis Highway
Arlington, VA 22202.

c. U.S. Postal Service, including Express Mail, addressed as follows:

BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231.

d. Facsimile (703-308-7953). **Papers exceeding five (5) pages in length cannot be filed by facsimile without prior permission of an administrator. A confirmation copy is not needed when filing a paper by facsimile.**

Hand-delivery to the Office of the Clerk of the Board will minimize the time it takes to (1) process the paper and (2) decide any request made in the paper.

4. Use of cover sheet in filing papers in interferences cases with the board

All papers filed with the board in connection with this interference shall have a pink cover sheet similar to the pink cover sheet accompanying this order.

5. Requirement for filing two copies of each paper

When presenting a paper in this interference, each party is required to submit (1) an original and (2) one copy of each paper, the copy shall be marked at the top:

"COPY FOR JUDGE"

6. Notice under 35 U.S.C. § 135(c)

Notice is hereby given of the requirement of 35 U.S.C. § 135(c) for filing in the PTO a copy of any agreement "in connection with or in contemplation of the termination of the interference." See Unisys Corp. v. Commissioner of Patents and Trademarks, 39 USPQ2d 1842 (D.D.C. 1993).

7. Lead and backup counsel

With fourteen (14) days of the date of this order, each party is required to identify in a separate paper

- a. a lead counsel (37 CFR § 1.613(a);
- b. a backup lead counsel;
- c. a mailing address;
- d. in the event the mailing address is a Post Office Box, an address where overnight packages may be delivered;
- e. telephone number;

f. facsimile number and

g. internet e-mail address, if available.

If lead counsel and/or backup counsel are not counsel of record (37 CFR § 1.34(b)) in the application or patent involved in this interference, then within **fourteen (14) days** of the date of this order, an appropriate power of attorney shall be filed.

8. Real party in interest

Within **fourteen (14) days** of the date of this order, each party shall notify the board in a separate paper of any and all right, title, and interest in any application or patent involved in the interference (37 CFR § 1.602(b)).

All parties are obligated to continually and promptly update changes of the real party in interest.

9. Request for copies of files

The parties to the interference have access to the patent and application files involved in the interference, as well as any benefit files identified in this order. 37 CFR § 1.612(a). The parties are advised that the interference file does not include any involved application, patent or benefit files, all of which are maintained separate from the interference file.

Within **fourteen (14) days** of the date of this order, each party shall file with the board (not another office in the Patent and Trademark Office) a separate paper requesting copies of those files identified in this order which that party would like to obtain. The request must include:

- a. a list by patent number and application number of the files desired,
- b. a Patent and Trademark Office Deposit Account to which fees may be charged for making copies, and
- c. a complete street, city and state address (not a P.O. Box) of the location where copies are to be shipped.

The parties are encouraged to file requests for copies by facsimile. Within **twenty-one (21) days** of the date of this notice, the board will forward all requests timely received and all necessary files to the Office of Public Records (OPR) for copies to be made and shipped via overnight delivery service. OPR has advised the board that copies will be made and shipped within **fourteen (14) days** of receipt of the request and files.

The parties are advised that from (1) the date of this order until (2) the date files are returned by OPR to the board, the files may be inspected only at the Office of the Clerk of the Board. The files will not be released to any individual outside the board for any purpose until the board receives the files from OPR (which will occur following shipment of copies). Hence, the files cannot be inspected while at OPR.

The parties are further advised that failure to timely request copies of files will under no circumstances constitute a basis for granting an extension of time (37 CFR § 1.645(a)).

The parties are requested to file a facsimile upon receipt of any files which were ordered.

10. Size of paper¹

With the possible exception of original exhibits of a different size, all papers (e.g., identification of lead counsel, identification of real party in interest, motions, preliminary motions, preliminary statements, copies of deposition transcripts, briefs, etc.) filed in this interference shall be

- a. 8½ x 11 inch paper or
- b. A4.

The board prefers use of 8½ x 11 inch paper. Papers of a different size (e.g., legal size) shall not be filed.

11. Holes at the top of papers²

All papers filed in this interference shall have two holes punched at the top spaced at 2-3/4 inches apart (each hole spaced equidistant from an imaginary center line running from the top to the bottom of the paper) so that the papers may be placed in interference files maintained by the PTO.

12. Prohibition against presenting duplicate papers³

When presenting a paper in this interference, a party shall not submit with the paper (as an appendix, exhibit, or otherwise)

¹ The purpose of this requirement is to facilitate storage of papers, files and evidence at the board.

² The purpose of this requirement is to facilitate placing papers in files and to avoid the need to unstaple papers, thereby minimizing the chance that a page of a particular paper will be misplaced.

³ The purpose of this requirement is to minimize the size of files and facilitate storage of material in the limited storage space available to the board.

a copy of a paper previously filed in the interference (37 CFR § 1.618(b)).

13. Prohibition against incorporation by reference of arguments made in another paper⁴

Arguments presented in one paper shall not be incorporated by reference to another paper.

14. Citation of case law in papers

When citing a decision of a court which is published in the West Reporter System and the USPQ, counsel should provide parallel citations, e.g., Aelony v. Arni, 547 F.2d 566, 192 USPQ 486 (CCPA 1977); In re Deckler, 977 F.2d 1449, 24 USPQ2d 1448 (Fed. Cir. 1992).

Binding precedent is the following:

- a. Decisions of the U.S. Supreme Court.
- b. Decisions of the Court of Appeals for the Federal Circuit, the former CCPA and the former Court of Claims. See South Corp. v. United States, 690 F.2d 1368, 1370-71, 215 USPQ 657, 657-58 (Fed. Cir. 1982) (en banc), and In re Gosteli, 872 F.2d 1008, 1011, 10 USPQ2d 1614, 1616-17 (Fed. Cir. 1989) (where there is a conflict between two or more decisions of the former CCPA, the later CCPA decision controls).
- c. Decisions of the Commissioner of Patents and Trademarks.

⁴ The purpose of this requirement is to minimize the chance that an argument will be overlooked and to maximize the efficiency of the decision-making process.

d. Decisions of the Board of Patent Appeals and Interferences which have been determined to be binding precedent under the board's Standard Operating Procedure 2. See, e.g., Reitz v. Inoue, 39 USPQ2d 1838 (Bd. Pat. App. & Int. 1995).

Decisions of the regional courts of appeals and the district courts may be cited, but are not binding precedent.

Non-precedential decisions of federal courts shall not be cited.

Non-precedential decisions of the board may be cited, but are not binding.

The Manual of Patent Examining Procedure (MPEP) is a guide for patent examiners which is prepared by the Office of the Assistant Commissioner for Patents. The MPEP contains Chapter 2300 on interference practice. Chapter 2300 is often out of date with respect to interference law and practice. Hence, Chapter 2300 of the MPEP is not to be cited in papers filed in this interference. Counsel should instead cite only primary authority: the United States Code (USC), the Code of Federal Regulations (CFR), notices published in the Federal Register and/or Official Gazette, and binding precedent.

15. Copies of precedent relied upon

The parties are encouraged to submit with papers copies of court opinions and statutes relied upon for use by board personnel--the copies of court opinions and statutes will not become part of the record. The parties are required to submit with the document in which a court opinion is cited a copy of any

opinion which is not reported in West Publishing Company's Supreme Court Reporter, the F.2d, or the F.3d and the USPQ or USPQ2d.

16. Service of papers by hand or Express Mail⁵

All papers served on opposing counsel in this interference shall be served by Express Mail (an overnight one-day delivery service of the U.S. Postal Service) (37 CFR § 1.646(d)); alternatively counsel may serve opposing counsel using any means which accomplishes an overnight one-day delivery, e.g., by hand, facsimile, or a commercial overnight delivery service.

The day a facsimile is transmitted, an overnight package is delivered to a courier or a paper is served by hand does not count in the calculating of the time for filing a response.

17. Conference call to set dates

A telephone conference call to set dates for action in this interference is scheduled for 9:30 a.m. on November 4, 1998 (the call will be initiated from the PTO).

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference is enclosed. Counsel are encouraged to discuss the order by phone prior to the telephone conference call and to come to some mutual agreement as to dates for taking action.

⁵ The purpose of this requirement is to place all parties on a level playing field by avoiding different delivery times which inherently occur through the use of the U.S. Postal Service.

18. Headings to be used on papers in the interference⁶

In papers filed with the board by party in this interference, the heading shown in the attached Appendix shall be used.

19. Copies of patents and literature mentioned in each specification (and translations, if available)⁷

Within one (1) month of the date of this order, each party:

a. shall serve on all opponents a legible copy of every patent, literature reference and test standard (i.e., an ASTM test), and in the case of patents, literature or test standards in a foreign language, a translation, if available, mentioned in the specification of the party's involved patent and/or application and/or application upon which the party will rely for benefit, and

b. shall file with the board a notice (without copies of the patents or literature) that it has served the patents and literature as ordered herein.

Upon a future request by the board, the parties should be prepared to promptly file copies of the patent, literature references and/or test standards.

⁶ The purpose of this requirement is to standardize headings, to be able to immediately recognize which party is filing the paper and to facilitate calls by the staff of the board in the event correction is needed.

⁷ The purpose of the additional discovery ordered by this requirement is to place the parties on a level playing field. A party should have access to documents cited in its specification and it may be difficult for an opponent to locate those documents. 37 CFR § 1.687(c).

20. Clean copy of claims⁸

Within fourteen (14) days of the date of this order, each party shall file two (2) copies of a clean set of all claims (as they exist as of the date of the declaration of this interference)

- a. pending in the party's involved application or
- b. contained in the party's involved patent

(including any changes which took place by way of a certificate of correction after granting of the patent and before declaration of the interference).

21. Copy of papers in electronic form⁹

Upon a future request by the board, the parties should be prepared to promptly file a computer 3½ inch high density floppy disk (for use in an IBM compatible computer) containing any of the following documents:

- a. the specification,
- b. the claims,
- c. any motion, opposition or reply,
- d. affidavit¹⁰ testimony, and
- e. transcripts of cross-examination.

⁸ The purpose of this requirement is to have readily available a clean copy of the claims of the parties. In applications, claims are often spread throughout the file. In patents, there are often certificates of correction.

⁹ The purpose of this paragraph is to put the parties on notice that the board may require documents in electronic form. Often documents in electronic form are more easily searched and can minimize the chance that an argument will be overlooked.

¹⁰ Affidavit includes a declaration. 37 CFR § 1.601(b).

22. Time to respond to miscellaneous motions under 37 CFR § 1.635

There are three kinds of motions which can be filed in an interference:

- a. A preliminary motion under 37 CFR § 1.633.
- b. A motion to correct inventorship under 37 CFR § 1.634.
- c. A miscellaneous motion under 37 CFR § 1.635.

The time for filing an opposition to a miscellaneous motion under 37 CFR § 1.635 is hereby set to be **five (5) working days** after service of the motion. 37 CFR § 1.638(a).

The time for filing a reply to an opposition to a miscellaneous motion under 37 CFR § 1.635 is hereby set to be **three (3) working days** after service of the opposition. 37 CFR § 1.638(b).

A motion under 37 CFR § 1.635 may be denied prior to receipt of an opposition. A motion under 37 CFR § 1.635 may be granted after an opposition is filed and prior to receipt of a reply.

23. Requests under 37 CFR § 1.642 to add an application or patent

A request pursuant to 37 CFR § 1.642 to add an application or patent to an interference shall be made in the form of a miscellaneous motion under 37 CFR § 1.635. Any motion should:

- a. identify the additional application or patent to be added;

- b. certify that a complete copy of the file wrapper or application has been served on all opponents; and
- c. explain which claims of the patent or application should be designated as corresponding to the count.

24. Manner of styling motions¹¹

The style of all motions, oppositions and replies shall appear on a single line, shall be free of the words "et al" and shall be consecutively numbered starting with number 1. In a second line, a party may specify the nature of the motion, i.e.:

- a. Jones Miscellaneous Motion 1
(for additional discovery)
- b. Jones Preliminary Motion 2
(for judgment based on prior art)
- c. Jones Preliminary Motion 3
(for judgment based on lack of enablement)
- d. Jones Motion to Correct Inventorship 4
- e. Smith opposition 1
(To Jones preliminary motion 2)
- f. Smith opposition 2
(To Jones motion to correct inventorship 4)
- g. Jones reply 1
(To Smith opposition 1)

¹¹ The purpose of this requirement is to simplify docket entries at the board.

25. Manner of presenting motion, oppositions and replies¹²

a. In presenting a motion, a party shall set out in the following order:

- (1) The precise relief requested (two examples are (a) Jones moves to be accorded the benefit of the filing date of application 07/999,999, filed January 22, 1993 or (b) Jones moves for judgment against Smith on the ground that Smith's claims 1, 2 and 5 corresponding to the count are unpatentable under 35 U.S.C. § 103 over the combined disclosures of U.S. Patent No. 4,444,444 (Johnson) and French Patent 1,111,111 (Boleau).
- (2) The evidence relied upon (i.e., a list of all exhibits by number) the moving party relies in support of the motion.
- (3) The facts in separately numbered paragraphs with a citation to the evidence.
- (4) The reasons why relief should be granted.

b. In presenting an opposition, a party shall set out in the following order:

¹² The purpose of these requirements is to facilitate consideration of motions, to minimize the chance that an argument will be overlooked and to make it easier to determine whether a reply raises new issues.

- (1) The evidence relied upon (i.e., a list of all exhibits by number) the opposing party relies in support of the opposition.
- (2) Whether each fact alleged by the moving party is admitted, denied or that the opposing party is unable to admit or deny the fact alleged.
- (3) Any additional facts upon which the opposing party intends to rely with a citation to the evidence.
- (4) the reason why relief is opposed in the following manner: "On page x, lines y-z of the motion, it is argued that _____. The response is _____."

c. In presenting a reply, a party shall set out in the following order:

- (1) The evidence relied upon (i.e., a list of all exhibits by number) the moving party relies in support of the reply.
- (2) Whether each additional fact alleged by the opposing party is admitted, denied or that the moving party is unable to admit or deny the fact alleged.
- (3) Any additional facts upon which the moving intends to rely to rebut additional facts

alleged by the opposing party with a citation to the evidence.

- (4) The argument responsive to statements in the opposition in the following manner: "On page x, lines y-z of the opposition, it is argued that _____. The response is _____."

26. Order accompanying motions¹³

Each motion and opposition shall be accompanied by two (2) copies of a proposed order suitable for entry by the administrative patent judge. The form of the order should be as follows: "Upon consideration of Jones Miscellaneous Motion 4 and Smith opposition 5 thereto, it is ordered that the motion is granted (or denied)."

The last page of the proposed order shall contain a list of the counsel, their addresses and facsimile numbers to which the order shall be sent.

27. Page number limitation on motions, oppositions and replies

A motion is limited to twenty-five (25) pages, not including any certificate of service.

An opposition to a motion is limited to twenty-five (25) pages, not including any certificate of service.

¹³ The purpose of this requirement is to permit motions to be decided and communicated as promptly as possible, particularly those which do not require an opinion.

A reply to an opposition is limited to ten (10) pages, not including any certificate of service, and shall not raise any issue or rely on any evidence which reasonably could have been made or presented with the motion.

28. Use of double space typing

All typing in all papers (including quoted material and footnotes, but excluding headings, signature blocks and certificates of service) shall be double spaced. The use of footnotes is discouraged.

29. "Combined" oppositions and replies not to be filed

An opposition shall respond to only a single motion; "combined" oppositions responding to more than one motion shall not be filed.

A reply shall respond to only a single opposition; "combined" replies to more than one opposition shall not be filed.

30. No new issues to be raised in replies

As provided by the rules, no new issues are to be raised in replies.

A new issue will be deemed to be raised in a reply if the reply refers to new evidence which is necessary to make out a prima facie case for the relief requested in, and/or which could have been included with, the motion.

A reply which is longer than a motion or an opposition probably raises new issues.

If a reply raises any new issue or belatedly relies upon evidence which should have been earlier presented, **the entire reply and belatedly relied upon evidence will not be considered.** The board will not attempt to sort out legitimate reply from improper reply.

**31. Conference call prior to filing contested
Rule 635 motion**

Prior to filing a miscellaneous motion under 37 CFR § 1.635, a party shall:

- a. confer with all opponents as required by 37 CFR § 1.637(b) and, if agreement cannot be reached,
- b. place a conference call to the administrative patent judge designated to handle this interference.

A motion for a clarification of the procedure to be used in this interference shall not be filed until a conference call has been placed to the administrative patent judge designated to handle this interference.

32. Time for objection to admissibility of evidence

Any objection to the admissibility of evidence, including evidence filed with any motion, opposition or reply shall be filed within **five (5) working days** of service of the evidence to which the objection is made, including evidence presented in connection with a preliminary motion.

33. Time for serving supplemental affidavits

Any supplemental affidavit to respond to any objection to the admissibility of evidence shall be served (but not filed) within **two (2) weeks** of the date an objection was served.

34. Time for cross-examination

Cross-examination of any affiant may take place **twenty-one (21) days¹⁴** after service of an affidavit.

Cross-examination of an affiant relied upon in a preliminary motion shall take place before an opposition to the preliminary motion is filed.

Cross-examination of an affiant relied upon in an opposition to a preliminary motion shall take place before a reply is filed.

35. Order of cross-examination

The party asking for cross-examination, upon reasonable notice, shall have the right to select the order in which cross-examination occurs when more than one witness is to be cross-examined.

36. Reliance on a paper in a patent or application file

If a motion relies on a paper in the file of an involved or benefit patent and/or application (including a specification and/or drawings) involved in the interference, a copy of the paper should be made an exhibit.

¹⁴ The twenty-one (21) day period is sufficient to allow for objections to the admissibility of evidence and the filing of supplemental affidavits.

37. Manner of labelling exhibits¹⁵

Exhibits used by a party in this interference shall be assigned consecutive numbers throughout the course of the interference.

Exhibits should be identified by an exhibit numbers (not letters) on a label placed in the lower right-hand corner of the first page of the exhibit. Compare 37 CFR § 1.653(i).

If important material is covered by an exhibit label on the first page of the exhibit, a copy of the first page of the exhibit may be reproduced and presented as page 1-a of the exhibit.

Exhibits should be labeled, e.g., as follows:

Jones EXHIBIT 1001
Jones v. Smith
Interference 108,111

Smith EXHIBIT 2001
Jones v. Smith
Interference 108,111

Affidavits relied upon during the course of the interference shall be assigned an exhibit number.

The party currently designated as junior party shall consecutively number exhibits beginning with Exhibit 1001.

The party currently designated as senior party shall consecutively number exhibits beginning with Exhibit 2001.

At the conclusion of the preliminary motion period and at the time the record on the issue of priority is filed, the

¹⁵ The purpose of this requirement is to maximize the chance that any misplaced exhibit can be associated with the proper interference and to facilitate identification during deliberations as to who filed an exhibit.

parties should plan on submitting all original exhibits, including affidavits, in an accordion folder, box or other folder containing all exhibits in numerical order, the idea being that each motion, opposition, reply, affidavit or transcript of cross-examination shall refer to the exhibit by number.

The filing of multiple copies of the same exhibit with different exhibit numbers is not authorized.

38. Exhibit list

Each party shall maintain an exhibit list. The list shall contain the exhibit number and a brief description thereof. Upon request by the board, the party should be prepared to file a copy of the exhibit list.

39. Specification as evidence

A specification of an application or patent involved in the interference is admissible as evidence only to prove what the specification or patent describes. If there is data in the specification upon which a party intends to rely to prove the truth of the data, an affidavit by an individual having first-hand knowledge of how the data was generated (i.e., the individual who performed an experiment reported as an example in the specification) must be filed.

The individual will be subject to cross-examination.

40. Affidavits of expert witnesses

Affidavits expressing an opinion of an expert used in connection with preliminary motions must disclose the underlying

facts or data upon which the opinion is based. See Fed. R. Evid. 705 and 37 CFR §§ 1.639(b) and 1.671(b).

Opinions expressed without disclosing the underlying facts or data may be given little, or no, weight. See Rohm and Haas Co. v. Brotech Corp., 127 F.3d 1089, 1092, 44 USPQ2d 1459, 1462 (Fed. Cir. 1997) (nothing in the Federal Rules of Evidence or Federal Circuit jurisprudence requires the fact finder to credit the unsupported assertions of an expert witness).

41. Reliance on scientific tests and data

Parties often rely on scientific tests and data, both in the preliminary motion phase and during the priority testimony phase. Examples include IR (infra-red) and graphs generated therefrom, HPLC (high performance liquid chromatography) and data generated therefrom, etc. In the event a party relies on a scientific test or data generated from a scientific test, the party relying on the test or data shall explain:

- a. the reason why the test is being used and why the data is being relied upon;
- b. how the test is performed;
- c. how the data is generated using the test;
- d. how the data is used to determine a value;
- e. the acknowledged accuracy of the test; and
- f. any other information which the party believes would aid the board in understanding the significance of the test and/or data.

The explanation desirably takes place through an affidavit testimony of a witness, preferably accompanied by references to relevant pages of standard texts (which should be exhibits in the interference).

42. Letters between counsel not to be filed

Unless a letter between counsel is made an exhibit to a motion, opposition, reply, affidavit or during cross-examination, no letters between counsel are to be filed with the board.

43. Guidelines for cross-examination

Cross-examination is a useful tool for determining the facts in a case. In interference cases, testimony is initially presented by affidavit. 37 CFR § 1.639(b); 37 CFR § 1.672(b) and (c). Cross-examination occurs by oral deposition. 37 CFR § 1.672(d). With respect to the cross-examination depositions, the guidelines of Hon. Robert S. Gawthrop, III, U.S. District Judge, essentially as set out in his opinion in Hall v. Clifton Precision, a division of Litton Systems, Inc., 150 F.R.D. 525 (E.D. Pa. 1993), shall apply as hereinafter discussed. There is only one basic exception and that exception is due to PTO rules. Objections must be noted on the record. See 37 CFR § 1.675(c).

As Judge Gawthrop notes, a deposition is meant to be a question-and-answer conversation between the deposing lawyer and the witness. There is no proper need for the witness's own lawyer to act as an intermediary, interpreting questions, deciding which questions the witness should answer, and helping

the witness to formulate answers. The witness comes to the deposition to be questioned on cross-examination. It is the witness, and not the lawyer, who is the witness.

In view of the above, and pursuant to 37 CFR § 1.610(e), the following guidelines shall apply.

Guideline [1]

At the beginning of the deposition, deposing counsel taking cross-examination shall instruct the witness on the record to ask deposing counsel, rather than the witness's own counsel, for clarifications, definitions or explanations of any words, questions or documents presented during the course of the deposition. The witness shall abide by the instructions.

Guideline [2]

Counsel shall not direct or request that a witness not answer a question, unless:

(1) counsel has objected to the question on the ground that the answer would:

- (a) reveal privileged material or
- (b) violate a limitation imposed by an administrative patent judge or a panel of the Board of Patent Appeals and Interferences and

(2) counsel immediately places a telephone conference call to the administrative patent judge designated to handle this interference asking orally for a ruling on the objection.

Under these circumstances, (1) the deposition shall be suspended, (2) the telephone conference call immediately shall be placed to the administrative patent judge designated to handle this interference, and (3) all counsel must be prepared to address orally their respective positions. A court reporter, preferably the court reporter at the deposition, shall be available to record any telephone discussion and to read back questions to which an objection has been made.

If an administrative patent judge cannot be reached, then the party directing a witness not to answer shall, within **two (2) working days**, hand deliver to the Board (Crystal Gateway 2, 10th Floor, 1225 Jefferson Davis Highway, Arlington, Virginia), and not to the PTO Mail Room or any other PTO office, a motion under 37 CFR § 1.635 seeking relief. Any opposition must be hand delivered to the Board within **two (2) working days**. While a reply can be filed, counsel should assume that the motion is under advisement and can be decided at any time upon (a) receipt of an opposition, or (b) failing timely hand delivery of an opposition, then immediately.

Guideline [3]

Counsel shall not make objections or statements which might suggest an answer to a witness. Any objection to evidence during a deposition shall be stated concisely and in a non-argumentative and non-suggestive manner. Opposing counsel should not address the correctness of an objection. Rather, opposing counsel should

continue with questions to the witness, the objection having been noted on the record as required by 37 CFR § 1.675(c).

With respect to this guideline, following observation by Judge Gawthrop should be noted:

I also note that a favorite objection or interjection of lawyers is, "I don't understand the question; therefore the witness doesn't understand the question." This is not a proper objection. If the witness needs clarification, the witness may ask the deposing lawyer for clarification. A lawyer's purported lack of understanding is not a proper reason to interrupt a deposition. In addition, counsel are not permitted to state on the record their interpretations of questions, since those interpretations are irrelevant and often suggestive of a particularly desired answer.

By way of example, the following comments by counsel not conducting cross-examination generally are viewed as suggesting an answer to a witness:

1. Objection, vague.
2. Objection, to the form of the question.
3. Take your time in answering the question.
4. Look at the document before you answer.
5. Counsel, do you want to show him/her the document?

Guideline [4]

Counsel and their witness-clients shall not engage in private, off-the-record conferences during depositions or during breaks or recesses, except for the purpose of deciding whether to assert a privilege. The term "witness-clients" in the context of this guideline and patent interference practice includes all witnesses who are employed by, or otherwise under the control of, the real party in interest in the interference, including retained expert witnesses, as well as the individual or individuals named in the caption of the interference.

With respect to this guideline, following observation by Judge Gawthrop should be noted:

The fact that there is no [administrative patent] judge in the room to prevent private conferences does not mean that such conferences should or may occur. The underlying reason for preventing private conferences is still present: they tend, at the very least, to give the appearance of obstructing the truth.

Guideline [5]

Any conferences which occur pursuant to, or in violation of, guideline [4] are a proper subject for inquiry by deposing counsel to ascertain whether there has been any witness-coaching and, if so, what.

Guideline [6]

Any conferences which occur pursuant to, or in violation of, guideline [4] shall be noted on the record by the counsel who

participated in the conference. The purpose and outcome of the conference shall also be noted on the record.

Guideline [7]

Deposing counsel taking cross-examination shall provide to the witness's counsel a copy of all documents shown to the witness during the deposition. The copies shall be provided either before the deposition begins or contemporaneously with the showing of each document to the witness. The witness and the witness's counsel do not have a right to discuss documents privately before the witness answers questions about the documents.

Failure to adhere strictly to these guidelines may be a basis for a sanction under 37 CFR § 1.616, which could include a requirement that the witness, on very short notice (i.e., the next day including if appropriate a non-work day) may be directed to appear before at the board in Arlington, Virginia or elsewhere as may be appropriate, coupled with any appropriate award of compensatory damages under Rule 616. In addition, cross-examination undertaken contrary to these guidelines may result in exclusion of an affidavit from evidence or little, if any weight, being given to the direct testimony of a witness who was cross-examined.

44. Comments on requests for extensions of time

The parties are advised that times have been set with the view to rendering prompt and timely decisions. Thus, in setting times in this interference, also taken into account are times set

in other interference and decisions which need to be rendered in this interference, as well as other interference.

It is true that requests for extension of time are authorized by 37 CFR § 1.645. But, Rule 645 requires a showing of "good cause." Whatever counsel's experience may be in other PTO matters, prior interferences or courts generally, the standard of what constitutes "good cause" within the meaning of Rule 645 is considerably high.

There are few, if any, circumstances where "good cause" can be based on the press of other business arising after a time is set by an order entered in this interference, particularly where a time period is set after conference with counsel. Thus, a matter in another case (i.e., argument or a trial) or an event (i.e., a deposition, client meeting in the U.S. or abroad) scheduled or ordered after a conference call, in which a time is set in this interference, normally will not constitute the press of other business.

Generally, an attempt to settle is not "good cause." While settlement is encouraged, and the administrative patent judge designated to handle this interference is available to assist in settlement efforts where appropriate, the parties should expect to either settle interference or, in the absence of settlement, to meet the next pending deadline.

Fred McKelvey

FRED E. McKELVEY
Senior Administrative Patent Judge

Attachment
(37 CFR § 1.611(c))

The parties involved in this interference are:

Junior Party

Named inventors: Richard A. Lerner, La Jolla, CA
Joseph A. Sorge, Rancho Santa Fe, CA

Application: Application 07/941,761,
filed November 25, 1992

Title: Method for producing polymers having a
preselected activity

Assignee: None

Attorneys: HOWREY & SIMON

Accorded Benefit: Application 07/799,772,
filed November 27, 1991

Application 07/496,522,
filed March 20, 1990,

Application 07/411,058,
filed September 21, 1989

Application 07/410,716,
filed September 20, 1989

Application 07/410,749,
filed September 20, 1989

Application 07/352,884,
filed May 17, 1989

Application 07/352,927
filed May 16, 1989

Address: HOWREY & SIMON
Box No. 34
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2402

Junior Party

Named inventors: Richard A. Lerner, La Jolla, CA
Joseph A. Sorge, Rancho Santa Fe, CA

Application: Application 07/941,762,
filed September 4, 1992

Title: Method for tapping the immunological
repertoire

Assignee: None

Attorneys: HOWREY & SIMON

Accorded Benefit: Application 07/809,083,
filed December 9, 1991

Application 07/446,332,
filed December 4, 1989

Application 07/353,241,
filed May 17, 1989

Application 07/353,235,
filed May 16, 1989

Address: HOWREY & SIMON
Box No. 34
1299 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2402

Senior Party

Named Inventors: Gregory P. Winter, Cambridge, UK
Elizabeth S. Ward, Cambridge, UK
Detlef Gussow, Cambridge, UK

Application: Application 08/332,046,
filed November 1, 1994

Title: Single domain ligands, receptors comprising
said ligands, methods for their production
and use of said ligands and receptors

Assignee: None

Attorneys: NIXON & VANDERHYE

Accorded Benefit: Application 07/796,805,
filed November 25, 1991

Application 07/580,374,
filed September 11, 1990

PCT application PCT/GB89/01344,
filed November 13, 1989

UK application 8918543.3,
filed August 15, 1989

UK application 8913900.0,
filed June 16, 1989

UK application 8912652.8,
filed June 2, 1989

UK application 8911047.2,
filed May 15, 1989

UK application 8909217.5,
filed April 22, 1989

UK application 8906034.7,
filed March 16, 1989

UK application 8826444.5,
filed November 11, 1988

Address: NIXON & VANDERHYE
1100 North Glebe Road
8th Floor
Arlington, VA 22201

Count 1

A method according to any of claims 17, 26 or 31 of Lerner '761 or any of claims 32, 41, 45, 55, 59, 67, 71, 80 or 90 of Lerner '762 or a method according to 49 or 53 of Winter '046

or

a vector according to any of claims 29, 30 or 32 of Lerner '761

or

a coexpression vector according to any of claims 39 or 65 of Lerner '762

or

an expression vector according to claim 53 of Lerner '762

or

a genetic library according to any of claims 78, 79, 88, 89, 96 or 97 of Lerner '762.

The claims of the parties are:

Lerner 07/941,761 17-22, 24-26, 29-32

Lerner 07/941,762 32-37, 39-41, 44-45, 47-51, 53-55,
58-67, 70-76, 78-86 and 89-97

Winter 08/332,046 33-37 and 39-66

The claims of the parties which correspond to Count 1 are:

Lerner 07/941,761 17-22, 24-26, 29-32

Lerner 07/941,762 32-37, 39-41, 44-45, 47-51, 53-55,
58-67, 70-76, 78-86 and 89-97

Winter 08/332,046 49 and 53-56

The claims of the parties which do not correspond to Count 1
are:

Lerner 07/941,761 None

Lerner 07/941,762 None

Winter 08/332,046 33-37, 39-48, 50-52 and 57-66

The PTO-850 forms and the examiner's Rule 609(b) statements

Interference 104,271 and Interference 104,272 are being declared simultaneously and appear to involved the same real parties in interest.

The examiner prepared a Form 850 for each interference, but prepared a single 609(b) statement for both interferences. In the PTO-850 forms and the Rule 609(b) statement, the following is manifest:

45. "Count 1" was proposed for the count of what has become Interference 104,271.
46. "Count 2" was proposed for the count of what has become Interference 104,272.
47. Huse 07/933,958 is identified as Party 1 (see page 5 of the Rule 609(b) statement).
48. Huse 07/933,959 is identified as Party 2 (see page 7 of the Rule 609(b) statement).
49. Lerner 07/941,761 is identified a Party 3 (see page 10 of the Rule 609(b) statement).
50. Lerner 07/941,762 is identified a Party 4 (see page 12 of the Rule 609(b) statement).
51. Winter is identified as Party 5 (see the Form 850's for each interference and page 14 of the Rule 609(b) statement).

A count should include the patentable subject matter of all of the claims designated as corresponding to the count. In this case, the examiner has indicated that all of the parties' claims

are patentable. The examiner has further indicated that all of the parties' claims correspond to the count proposed for what has become Interference 104,271 or the count proposed for what has become Interference 104,272. Neither count proposed by the examiner includes all of the subject matter of the claims proposed by the examiner to be designated to correspond to that count. For example, claim 23 of Huse 07/933,958, involved in Interference 104,271, covers an "expression vector" (which, of course, is not a process). Claim 78 of Lerner 07/941,762, involved in Interference 104,272, covers a "genetic library" (which, of course, is also not a process). Hence, the counts, as proposed by the examiner--which were limited to processes, have not been accepted. In place of the counts proposed by the examiner, a count is set out in each interference which includes within its scope all of the patentable subject of all claims designated to correspond to that count.

According to the examiner, the patentable difference between Count 1 of Interference 104,271 and Count 1 of Interference 104,272 is said to be that Count 1 of Interference 104,272:

requires the joining in operable combination the immunoglobulin sequences from the first immunoglobulin encoding library with the immunoglobulin sequences from the second immunoglobulin encoding library such that the first and second immunoglobulin sequences are combined in a random manner.

(Rule 609(b) statement, page 4, emphasis added). But, Count 1 of Interference 104,272 does not contain the word "random." The parties are free to address the separate patentability of Count 1 Interference 104,271 and Count 1 of Interference 104,272 in preliminary motions filed in either or both interferences.

Delay in the declaration of the interference

A review of the papers associated with the interference demonstrate that there has been an unacceptable delay between the time the examiner first signed a PTO-Form 850 (February 19, 1996) and the date the interferences are being declared. A review of all papers and records available do not provide a justification for the over two year, seven month period between February 19, 1996. What is known is that the files and the papers associated therewith went back-and-forth between the board and the examiner so that numerous deficiencies in the PTO-850 Form and the Rule 609(b) statement could be corrected. As it is, the count, as proposed by the examiner, still cannot be accepted. On September 2, 1998, an administrative patent judge was designated to handle the interference. Rather than forwarding the files and papers to the examiner for determination of a proper count, it has been determined that efficient administration of justice requires immediate declaration of these interferences. The delay between the original signing of the PTO-850 form and the declaration of the interference is regretted.

Appendix

Paper No. _____

Filed on behalf of: Party _____
By: Name of lead counsel, Esq.
Name of backup counsel, Esq.
Street address
City, State, and Zip-Code
Tel:
Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Senior Administrative Patent Judge Fred E. McKelvey)

RICHARD A. LERNER and JOSEPH A. SORGE,
Junior Party,

v.

GREGORY P. WINTER, ELIZABETH S. WARD and DETLEF GUSSOW
Senior Party.

Patent Interference No. 104,272

TITLE OF PAPER

cc (via Federal Express):

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Enc.

Sample ORDER concerning (1) FILING OF PRELIMINARY MOTIONS
AND STATEMENTS and (2) GUIDELINES FOR CROSS EXAMINATION

Copy of PTO Form 850, Rule 609(b) statements (if one was
prepared by the examiner), and related papers

Copy of specification and claims of involved applications
or patents